

REMARKS

This Amendment and Response is submitted in response to the Office Action mailed June 14, 2006. Applicant respectfully requests reconsideration on the merits of the outstanding rejections in view of the foregoing amendments and the following remarks. Claims 1-46 are currently pending.

A. Interview Summary

Pursuant to M.P.E.P. § 713.04, the substance of the interview conducted on August 29, 2006 with Applicant's representative Martin R. Bader and Examiner Michael J. Kyle is set forth below.

1. No exhibits were used or demonstrations conducted.
2. Independent claim 1 was discussed.
3. Two references were discussed: U.S. Patent Application No. 2002/0095745 to Wang ("Wang"), and U.S. Patent No. 1,031,024 to Pickles ("Pickles").
4. As described in the Interview Summary Form completed by the Examiner, two general amendments to the claim were discussed. The first was to describe the reinforcing mechanism as not projecting beyond an internal surface of the external segment. The second was to describe the reinforcing mechanism as having a bottom surface lying at or below the plane of an internal surface of the external segment.
5. Several arguments were made regarding the impropriety of combining Wang and Pickles, as there is no teaching, suggestion, or motivation to do so.
 - In the *Amendment and Response to Office Action Under 37 C.F.R. § 1.116* filed March 29, 2006, it was argued that there is a lack of motivation to combine Wang

and Pickles because the combination would result in an inoperative device. In response to Applicant's argument, the Examiner replied that "one having ordinary skill in the art would recognize that a clearance would be necessary for proper functioning." *See* Office Action mailed June 14, 2006 at page 8. However, as pointed out in the interview, the test is not whether one skilled in the art would be capable of combining the references, but whether the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). A perusal of figures 2 – 10 of Wang makes it clear that there is little, if any, clearance between the retractable tubes, and there is certainly not enough clearance to prevent the washer of Pickles from impeding the tubes' operation. Accordingly, it was argued during the interview that the Examiner applied an invalid test and thus Wang and Pickles were improperly combined. The Examiner requested this argument to be made in writing to be further considered. No agreement was reached.

- It was argued that providing sufficient clearance to permit the grommet of Pickles to reside in a hole in Wang would result in a wobbly, weak, and undesirable retractable handle. The Examiner argued that Pickles encroaches minimally so that little, if any, modification would be necessary to the handle and the overall quality of the handle would not be affected. No agreement was reached.
- It was argued that Pickles only discloses reinforcing flexible materials such as cloth rather than reinforcing solid materials such as steel or aluminum. Neither

Pickles nor Wang even suggests that the deformation of metal or steel is a problem to be solved. The Examiner argued that Pickles teaches reinforcing any hole, regardless of the material the hole resides in, and that it is well known to utilize reinforcing mechanisms made from a material stronger than the material the hole resides in. No agreement was reached.

6. The objection to claims 1-10 from the Office Action mailed June 14, 2006 was addressed. Namely, Applicant requested clarification of the objection.

7. As noted in the Interview Summary Form, the Examiner agreed that both proposed amendments discussed above would overcome a rejection based on Pickles. In response to the objection of claims 1-10, the Examiner requested a statement in Applicant's response regarding whether the reinforcing mechanism is a part of the external segment or a part of the telescoping handle.

I. Formal Matters

A. Allowed Claims

Applicant notes with appreciation the indication on page 8 of the Office Action that claims 45 and 46 are allowed.

B. Overview of Claim Amendments

Claims 1, 2, 4, 5, 7-12, 14, 15, 17-19, 26-29, 31, 31, 34-36, 43, and 44 have been amended to more particularly describe the external segment and its relationship with the internal segment. Support for these amendments is found at least in paragraphs 20-24 and in Fig. 3 of the present application. No new matter has been added by way of these amendments.

C. The Objection to Claim 2

Claim 2 is objected to because it is unclear whether the “internal surface” recited in claim 2 is the same “internal surface” recited in claim 1. *See* Office Action at page 2. Claim 2 has been amended to recite “the internal surface” so that it is clear that the internal surface discussed in claim 2 is the same internal surface introduced and in claim 1. Accordingly, the Examiner is requested to withdraw the objection to claim 2.

D. The Objection to Claims 1-10

Claims 1-10 are objected to because it is allegedly unclear if the reinforcing mechanism is being claimed in combination with the external segment of a telescoping handle. *See* Office Action at page 2. As noted above in the interview summary, the Examiner requested a statement regarding whether the reinforcing mechanism is a part of the external segment or a part of the telescoping handle. Applicant submits that the reinforcing mechanism is part of an external segment. Applicant has amended independent claims 1, 11, and 28 to clarify the status of the reinforcing mechanism. The reinforcing mechanism is part of an external segment of a telescoping handle. Accordingly, the Examiner is requested to reconsider and withdraw the objection of claims 1-10.

II. Rejections

A. The Rejection of Claims 1, 4-7, 10-11, 14-17, 20-22, 25-28, 31-34, 37-39, and 42-44 Under 35 U.S.C. § 103(a)

Claims 1, 4-7, 10-11, 14-17, 20-22, 25-28, 31-34, 37-39, and 42-44 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent Application No. 2002/0095745 to Wang (“Wang”) in view of U.S. Patent No. 1,031,024 to Pickles (“Pickles”). *See* Office Action at page 3.

The Office Action states that Wang discloses a telescoping handle having an external segment (30) with a hole (35) configured to receive a locking pin (22). *See* Office Action at page 3. The Office Action states that Wang also discloses a telescoping handle having an inner segment (20) with the locking pin (22). *See id.* The Office Action recognizes that Wang fails to teach a reinforcing mechanism, but states that Pickles teaches a material with a hole, where the hole includes a reinforcement mechanism (12, 20) which has a height substantially greater than the thickness of the element in which it is placed, resides flush with an internal surface (at 14), and receives a member and prevents the material from being damaged by the member received in the hole. *See id.* The Examiner thus asserts that it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Wang as taught by Pickles so that a reinforcement mechanism is included in the holes (35) of Wang to prevent damage to the tube, or external member.

As discussed above in the interview summary, the combination of Wang and Pickles is improper. Nevertheless, though Applicant respectfully disagrees with the Examiner regarding the teachings of Wang and Pickles, and the propriety of combining Wang and Pickles, Applicant has amended independent claims 1, 11, and 28 as discussed with the Examiner. More specifically, independent claims 1, and 11, and 28 have been amended to recite:

“a reinforcing mechanism inserted inside the hole, secured to the member, and not projecting beyond the internal surface”

As the Examiner correctly observes, Wang does not disclose a reinforcing mechanism for a hole. *See* Office Action at page 3. It follows that Wang fails to disclose the claimed “reinforcing mechanism inserted inside the hole, secured to the member, and not projecting beyond the internal surface.” Pickles, however, describes a washer and a grommet provided

within the washer. Pickles teaches the use of a grommet with the washer for setting in a sheet material, such as rubber goods, hammocks, awnings, and other textile articles. *See, e.g.*, Pickles column 1, lines 11-16; Fig. 2. The Examiner accurately states that the reinforcing mechanism of Pickles projects beyond both inner and outer surfaces of the element in which it is placed. *See* Office Action at page 8. Accordingly, Pickles does not teach or suggest the claimed “reinforcing mechanism inserted inside the hole, secured to the member, and not projecting beyond the internal surface.” As discussed above, the Examiner agreed to this assertion during the interview.

Therefore, neither Wang nor Pickles, nor their combination teaches or suggests every element of independent claims 1, 11, or 28. Thus, Applicant respectfully submits that claims 1, 11, and 28, and the claims that depend therefrom, are patentable over Wang in view of Pickles. The Examiner is thus requested to reconsider and withdraw the rejection of independent claims 1, 11, and 28, and any claims that depend therefrom, as being unpatentable over Wang in view of Pickles.

B. The Rejection of Claims 2, 12, and 29 Under 35 U.S.C. § 103(a)

Claims 2, 12, and 29 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Wang in view of Pickles as applied to claims 1, 11, and 28, and further in view of U.S. Patent No. 6,883,208 to Huang (“Huang”). *See* Office Action at page 5.

Huang is directed towards a hedge shear with an extendible handle. *See, e.g.*, Huang Abstract. The handle has perforation slots and other holes (12, 22, etc.). The handle also has an outer surface with a raised portion (32). *See, e.g.*, Huang Fig. 2. However, Huang has absolutely no disclosure regarding reinforcing mechanisms of any kind inside any of the slots or holes, and

has no disclosure of a recessed portion on the inner surface of the handle opposite a hole. *See, e.g., id.*

Applicant submits that claims 2, 12, and 29 are patentable at least by virtue of their dependency from independent claims 1, 11, or 28, which, as discussed above, are patentable over Wang in view of Pickles. Because Huang fails to disclose a reinforcing mechanism of any kind inside a hole, Huang fails to teach or suggest the claimed “reinforcing mechanism inserted inside the hole, secured to the member, and not projecting beyond the internal surface,” and thus, does not cure the deficiencies of Wang and Pickles with respect to independent claims 1, 11, or 28.

In addition, claims 2, 12, and 29 each recite at least the following limitation not taught by Wang, Pickles, and Huang:

“wherein the internal surface comprises an L-shaped recess surrounding the hole”

The Examiner points to no teaching or suggestion in Huang, Wang, or Pickles related to a recess of any kind. *See* Office Action at page 5. Huang has absolutely no disclosure of the claimed internal surface comprising an L-shaped recess surrounding the hole. Indeed, the portion of the internal surface of the core tube (30) opposite the raised portion (32) has no recess of any kind; it forms a plane. *See, e.g.,* Huang Fig. 6. Likewise, there is no disclosure in Wang or Pickles regarding an L-shaped recess surrounding the hole.

Because Wang, Pickles, and Huang fail to teach or suggest every element of independent claims 1, 11, or 28, Applicant respectfully submits that claims 1, 11, and 28, and the claims that depend therefrom, including claims 2, 12, and 29, are patentable over Wang in view of Pickles and further in view of Huang. Also, because Wang, Pickles, and Huang fail to teach or suggest the claimed internal surface comprising an L-shaped recess surrounding the hole, the

combination of Wang, Pickles, and Huang cannot be said to render claims 2, 12, and 29 obvious. In view of the foregoing, the Examiner is requested to reconsider and withdraw the rejection of dependent claims 2, 12, and 29, and any claims that depend therefrom, as being unpatentable over Wang in view of Pickles and further in view of Huang.

C. The Rejection of Claims 8, 18, and 35 Under 35 U.S.C. § 103(a)

Claims 8, 18, and 35 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Wang in view of Pickles as applied to claims 7, 17, and 34, and further in view of U.S. Patent No. 5,984,064 to Byington (“Byington”). *See* Office Action at page 5.

Byington is directed towards an adjustable luggage handle. *See, e.g.*, Byington Abstract; Fig. 1. Wholly absent from Byington is any disclosure regarding a reinforcing mechanism of any kind inside a hole. *See, e.g.*, Byington Fig 2; Figs. 8-9. Applicant submits that claims 8, 18, and 35 are patentable at least by virtue of their dependency from independent claims 1, 11, or 28, which, as discussed above, are patentable over Wang in view of Pickles. Because Byington fails to disclose a reinforcing mechanism of any kind inside a hole, Byington fails to teach or suggest the claimed “reinforcing mechanism inserted inside the hole, secured to the member, and not projecting beyond the internal surface,” and thus, does not cure the deficiencies of Wang and Pickles with respect to independent claims 1, 11, or 28. Accordingly, the Examiner is requested to reconsider and withdraw the rejection of dependent claims 8, 18, and 35, and any claims that depend therefrom, as being unpatentable over Wang in view of Pickles and further in view of Byington.

D. The Rejection of Claims 9, 19, and 36 Under 35 U.S.C. § 103(a)

Claims 9, 19, and 36 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Wang in view of Pickles as applied to claims 7, 17, and 34, and further in view of U.S. Patent No. 6,125,513 to Cheraso, et al. (“Cheraso”). *See* Office Action at page 6.

Cheraso is directed towards a multi-function belt clip assembly. *See, e.g.*, Cheraso column 1, lines 6-7; Fig. 6. Wholly absent from Cheraso is any disclosure regarding a reinforcing mechanism of any kind inside a hole. *See, e.g.*, Cheraso Figs 1-7. Applicant submits that claims 9, 19, and 36 are patentable at least by virtue of their dependency from independent claims 1, 11, or 28, which, as discussed above, are patentable over Wang in view of Pickles. Because Cheraso fails to disclose a reinforcing mechanism of any kind inside a hole, Cheraso fails to teach or suggest the claimed “reinforcing mechanism inserted inside the hole, secured to the member, and not projecting beyond the internal surface,” and thus, does not cure the deficiencies of Wang and Pickles with respect to independent claims 1, 11, or 28. Accordingly, the Examiner is requested to reconsider and withdraw the rejection of dependent claims 9, 19, and 36, and any claims that depend therefrom, as being unpatentable over Wang in view of Pickles and further in view of Cheraso.

E. The Rejection of Claims 23, 24, 40, and 41 Under 35 U.S.C. § 103(a)

Claims 23, 24, 40, and 41 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Wang in view of Pickles as applied to claims 11 and 28, and further in view of U.S. Patent No. 5,690,217 to Friday (“Friday”). *See* Office Action at page 6.

Friday is directed towards a movable laundry storage unit. *See, e.g.*, Friday Abstract. Absent from Friday is any disclosure regarding a reinforcing mechanism of any kind inside a

hole. *See, e.g.*, Friday Figs. 7a-8b (showing no reinforcing mechanism in the apertures (65, 67, 71)). Applicant submits that claims 23, 24, 40 and 41 are patentable at least by virtue of their dependency from independent claims 1, 11, or 28, which, as discussed above, are patentable over Wang in view of Pickles. Because Friday fails to disclose a reinforcing mechanism of any kind inside a hole, Friday fails to teach or suggest the claimed “reinforcing mechanism inserted inside the hole, secured to the member, and not projecting beyond the internal surface,” and thus, does not cure the deficiencies of Wang and Pickles with respect to independent claims 1, 11, or 28. Accordingly, the Examiner is requested to reconsider and withdraw the rejection of dependent claims 23, 24, 40 and 41, and any claims that depend therefrom, as being unpatentable over Wang in view of Pickles and further in view of Friday.

F. The Rejection of Claims 1, 3, 11, 13, 28, and 30 Under 35 U.S.C. § 103(a)

Claims 1, 3, 11, 13, 28, and 30 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Wang in view of U.S. Patent No. 2,583,719 to White (“White”). *See* Office Action at page 7.

As discussed above, Wang fails to teach or suggest a reinforcing mechanism of any kind in a hole. Accordingly, the Examiner must rely on White to compensate for the deficiencies of Wang. White is directed towards a grommet to be mounted in glass or other easily broken material. *See, e.g.*, White column 1, lines 1-5. The grommet extends beyond both sides of the material (G) which it is inserted through. *See, e.g.*, White column 2, lines 16-20; Fig. 2.

Applicant submits that White fails to disclose at least the following limitations recited in independent claims 1, 11, and 28:

“a reinforcing mechanism inserted inside the hole, secured to the member, and not projecting beyond the internal surface”

Independent claims 1, 11, and 28, by reciting “a hole through the member extending from the internal surface to the external surface,” make it clear that the internal surface recited in independent claims 1, 11, and 28 is not the radially inner wall of the hole. Accordingly, it cannot be said that White discloses the claimed reinforcing mechanism that does not project beyond the internal surface; the grommet disclosed in White extends significantly beyond the internal and external surfaces of the material the grommet is put through. *See, e.g.*, White Fig. 2.

Furthermore, as in Pickles, there is no teaching, suggestion, or motivation to combine the telescoping handle of Wang with the grommet of White. As stated in *In re Gordon*, there is no motivation to combine references if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); M.P.E.P. §2143.01. White discloses a grommet that is purposefully designed to be significantly thicker than the material it is put through, as such a design permits force to be distributed over a larger area, permits the use of two washers, and permits the grommet to have an outwardly flaring surface. *See, e.g.*, column 2, lines 10-48; Fig. 2. The grommet disclosed in White would certainly not be capable of operating successfully with Wang. Figures 2 – 10 of Wang show that there is little, if any, clearance between the retractable tubes. There is not enough clearance to prevent the grommet of White from impeding the tubes’ operation.

Since neither Wang nor White teaches or suggests every element of independent claims 1, 11, or 28, and there is no teaching, suggestion or motivation to combine Wang with White, Applicant respectfully submits that claims 1, 11, and 28, and the claims that depend therefrom, are patentable over Wang in view of Pickles. The Examiner is thus requested to reconsider and

withdraw the rejection of independent claims 1, 11, and 28, and any claims that depend therefrom, as being unpatentable over Wang in view of White.

CONCLUSION

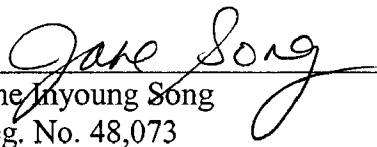
In view of the foregoing remarks, Applicant believes that the entire application is in condition for allowance and such action is respectfully requested. If it is believed that prosecution can be assisted thereby, the Examiner is invited to contact Applicant's undersigned representative at the below-listed telephone number.

No fee is incurred with the filing of this Amendment and Response to Office Action. However, the Commissioner is authorized to charge any fee that may be due, or with this application during its entire pendency, or to credit any overpayment to Deposit Account No. 50-2613, referencing 38841.00002.UTL.

Respectfully submitted,

Paul, Hastings, Janofsky & Walker LLP

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Jane Inyoung Song
Reg. No. 48,073

Paul, Hastings, Janofsky & Walker LLP
P.O. Box 919092
San Diego, CA 92191-9092
(858) 720-2500